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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/825,005	04/15/2004	Theodore A. Chapman	M-15340 US	7290
7590	07/12/2005			
Tom Chen MacPHERSON KWOK CHEN & HEID LLP Suite 226 1762 Technology Drive San Jose, CA 95110			EXAMINER WALSH, DANIEL I	
			ART UNIT 2876	PAPER NUMBER
DATE MAILED: 07/12/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/825,005

Applicant(s)

CHAPMAN ET AL.

Examiner

Daniel I. Walsh

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-18 and 27-32 is/are rejected.
- 7) ☒ Claim(s) 5, 19-26 and 33 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

1. Claims 1-3, 7-9, and 12-18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dunlap, JR. (US 2005/0098620).

Re claim 1, Dunlap, JR. teaches an RFID encoder coupled to program an RFID label (paragraph [0020], dispenser 19 of control); and an RFID label applicator to apply the programmed RFID label onto an object (applicator 20). Though Dunlap, JR. is silent to receiving a signal containing information for programming the RFID based on the signal, the Examiner notes that Dunlap, JR. teaches that a label is chosen from a plurality of labels and applied to an article as a function of the identity of the article (claim 1), and that the RFID label

is programmed and applied based on the identified article. Accordingly, it is obvious that a signal is received by the encoder so that it knows what to encode, and also so that the correct code is disposed. The Examiner notes that it is therefore obvious that a signal/unique identifier is generated and received to distinguish the article so that an appropriate label can be created and applied. Therefore, it is well within the skill in the art to use a signal to program the label accordingly, as a means to identify one article from another and program the label accordingly.

Re claim 2, Dunlap, JR. Teaches that each dispenser 19 may print a barcode on the RFID tag to be applied to the article (paragraph [0020]). Though Dunlap, JR. is silent to a host sending the signal to the RFID encoder in a first programming language, the Examiner notes that it is obvious that the command to print is in a computer/programming language for instructing the printing by the device. As the control controls the dispenser assembly 18 and the dispenser 19, the Examiner believes it is well within the skill in the art that such a signal would be generated by a computer/host computer/processor to instruct printing to the device, as is conventional in the art.

Re claim 3, Dunlap, JR. teaches that the determining characteristic of an article comprises reading a barcode (claim 25). As it has been discussed above that upon identifying an article, an appropriate RFID label can be written, the Examiner notes that it would have been obvious to one of ordinary skill in the art that such a signal be sent to the RFID encoder to encode the RFID label correctly.

Re claim 7, the limitations have been discussed above re claim 2.

Re claim 8, the limitations have been discussed above re claim 3.

Re claim 9, Dunlap, JR. teaches that object is a container (FIG. 1).

Re claim 12, Dunlap, JR. teaches that each dispenser 19 (coupled to the control) both prints the barcode and programs the RFID tag (paragraph [0020]). Accordingly, it is understood to receive a data stream.

Re claim 13, Dunlap teaches a conveyor for moving (FIG. 1).

Re claim 14, FIG. 2 of Dunlap, JR. shows the system. The Examiner notes that it is obvious that the label printer and applicator can apply the label to the package prior to the object passing by the RFID encoder, when the RFID encoder is disposed after the applicator 20. As dispenser 19 includes both an optical readable label printer and an RFID encoder, from FIG. 2, it is obvious that the dispenser 19 disposed towards the end of the path (indicated by the arrow) is after the applicator 20, and that the label would be printed and applied prior to passing, as it has to be printed at 19, and therefore it can't be printed after it passes 19.

Re claims 15-18, the teachings of Dunlap, JR. have been discussed above. Dunlap, JR. teaches receiving a signal comprising RFID programming information, programming the RFID using that information, and applying the RFID to the object (paragraph [0017]+) which teaches that a barcode is read and an RFID tag is encoded and applied from the signal obtained from the barcode.

2. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dunlap, JR., as discussed above, in view of Jusas et al. (US 2005/0029350).

The teachings of Dunlap, JR. have been discussed above.

Dunlap, JR. fails to teach that the RFID encoder verifies that information contained in an optically readable label matches data programmed on the RFID label.

Jusas et al. teaches that the barcode scanner may be in communication with the processor so that information scanned by the barcode reader can be encoded to the RFID component and that such scanned information can also be used to verify information already encoded on the RFID component (paragraph [0012]). Thus, it is believed that Jusas et al. provides motivation for verifying that the information in a optical label and RFID match.

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Dunlap, JR. with those of Jusas et al.

One would have been motivated to do this to ensure the correct information was encoded.

3. Claims 6, 10, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dunlap, JR., as discussed above, in view of Kimura et al. (US 5,229,587) and Hohberger et al. (US 20003/0227528).

The teachings of Dunlap, JR. have been discussed above.

Dunlap, JR. fails to teach verifying that the optically readable label has been properly printed.

Kimura et al. teaches that barcodes are verified after printing as either correct or ineffective (abstract) to reduce errors.

Hohberger et al. teaches that RFIDs are verified by comparing the data written to them to the data encoded thereon (interpreted as comparing the data to a data stream) (see claim 84 and 89 of Hohberger et al.) Though Hohberger teaches using a data stream (information from a

host/processor to verify information in a RFID tag, and not a barcode, the Examiner notes that it would have been obvious to one of ordinary skill in the art to apply the verification of one type of encoded data (RFID) to another type of encoded data (barcode/optical) motivated by the desire to ensure correct data writing.

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Dunlap, JR. with those of Kimura et al. and Hohberger et al.

One would have been motivated to do this to reduce the amount of defective printed barcodes. It is obvious that such a device would be adapted to receive the data stream in order to verify the printing.

Re claim 10, the limitations have been discussed above.

Re claim 11, Dunlap, JR. teaches that the dispensers 19 of assembly 18 can print barcode and encode RFID tags. Accordingly, in view of the teachings of Kimura et al., it would have been obvious to have the optical reader coupled to the RFID encoder, as they are part of the assembly/system/control 18 of Dunlap, JR., so that they can receive the data stream for printing and encoding.

4. Claim 27 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dunlap, JR. in view of Hohberger.

Re claim 27, the teachings of Dunlap, JR. have been discussed above.

Dunlap, JR. is silent to verifying whether the RFID label was properly programmed, before applying it.

Hohberger et al. teaches verifying a RFID transponder before attaching/printing (FIG. 7).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Dunlap, JR. with those of Hohberger et al.

One would have been motivated to do this in order to ensure the correctness of the RFID label.

Re claim 29, it is obvious that after the RFID is written, it is verified, as discussed above.

5. Claims 28, 31, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dunlap, JR./Hohberger et al., as discussed above, in view of Kimura et al.

The teachings of Dunlap, JR./Hohberger et al. have been discussed above.

Dunlap, JR./Hohberger et al. fail to teach determining whether the optical label was printed properly.

The teachings of Kimura et al. have been discussed above including verifying a printed barcode.

At the time the invention was made, it would have been obvious to an artisan of ordinary skill in the art to combine the teachings of Dunlap, JR./Hohberger with those of Kimura et al.

One would have been motivated to do this to ensure the barcode was correctly printed, to reduce errors.

Re claim 31, it is clear that verifying unit 23 of Kimura scans the optical label.

Re claim 32, though Hohberger teaches that the RFID is verified by comparing is with data written (interpreted as using a data stream, as it is understood that the written data is compared to that expected to be written), and is silent to a similar procedure for barcodes/optical data, the Examiner notes that it would have been obvious to one of ordinary skill in the art to

apply the verification of one type of encoded data (RFID) to another type of encoded data (barcode/optical) motivated by the desire to ensure correct data writing.

6. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dunlap, JR./Hohberger et al., as discussed above, in view of Jusas et al.

The teachings of Dunlap, JR./Hohberger et al. have been discussed above.

Dunlap, JR./Hohberger fail to teach comparing the barcode and RFID.

The teachings of Jusas et al. have been discussed above including comparing the RFID and barcode/optical code.

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Dunlap, JR./Hohberger et al. with those of Jusas et al.

One would have been motivated to do this in order to verify the encoded and printed data.

Allowable Subject Matter

7. Claims 5, 19-26, and 33 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. The following is a statement of reasons for the indication of allowable subject matter: The prior art of record fails to teach determining whether the optically readable label has been properly printed, determining whether the RFID label has been properly programmed, and applying the RFID label to the object if the optically readable label has been properly printed and the RFID label properly programmed, and that the data stream is different programming languages.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Beller et al. (US 5,602,377), Vega et al. (US 6,218,942), Wiklof et al. (US 6,246,326), Barrett et al. (US 6,593,853), Jarhcow et al. (US 6,597,465), Grunes et al. (US 6,816,075), Bennett (US 6,830,181), Barrus et al. (US 6,899,476), Mays et al. (US 2001/0048361), Casden (US 2002/0047777), Alicot et al. (US 2002/0105424), Garber et al. (US 2002/0167406), Eisenberg et al. (US 2002/0196126), Appalucci et al. (US 2003/0057276), Hogerton et al. (US 2003/0189490), Moylan et al. (US 2004/0032443), Salim et al. (US 2004/0113791), Kovach (US 2004/0129769), Alleshouse (US 2004/0149826), Grunes et al. (US 2004/0257231), Aupperle et al. (US 2005/00001719), Chapman et al. (US 2005/0058483), Matthewson et al. (US 2005/0073417), Satake et al. (US 2005/0116034), Hopwood et al. (US 2005/0139663), and Barrus et al. (US 2005/0139667).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel I. Walsh whose telephone number is (571) 272-2409. The examiner can normally be reached on M-F 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel I Walsh

Examiner

Art Unit 2876

7-9-05



Daniel I Walsh